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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------|-------------|----------------------|-------------------------|------------------|
| 10/786,817 | 02/24/2004 | Leo W. Davis | DTIN-27,616US | 5123 |
| 31782 | 7590 | 11/13/2006 | EXAMINER | |
| CHAUZA & HANDLEY, L.L.P. | | | SCHWARTZ, CHRISTOPHER P | |
| PO BOX 140036 | | | ART UNIT | |
| IRVING, TX 75014 | | | PAPER NUMBER | |
| | | | 3683 | |

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,817

Applicant(s)

DAVIS, LEO W.

Examiner

Christopher P. Schwartz

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 12, 13 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 5-7, 10, 11, 14, 15, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some.* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Applicant's response filed August 28, 2006 has been received and considered.

The election requirement made in the previous Office Action has been withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 12-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 12 it is unclear from the specification what "seal" applicants are claiming.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 rejected under 35 U.S.C. 103(a) as being unpatentable over Rubel in view of Gordaninejad et al..

Regarding claim 1 Rubel, as clearly can be seen in the drawings, shows a suspension strut comprising a primary fluid chamber 6, a secondary fluid chamber 5, a displacement member 7,8, and a "compressible ER fluid" (since all fluids are compressible to some degree -- even if small). Note the sleeve at 9 or 11 and the apertures at 22 and 33-35. Although not applied see the similarly structured reference to Delchev and note the location of the apertures may be changed or altered in Rubel.

Lacking in Rubel is a showing of an electromagnetically controlled fluid.

It is notoriously well known that ER and MR fluids are interchangeable in the art of motor vehicle suspension systems. Although not applied see Schwemmer et al. claim 5.

The reference to Gordaninejad et al. is relied upon to provide an example of an MR fluid type damper.

It would have been obvious to the ordinary skilled worker in the art to have modified the damping apparatus of Rubel to include electromagnetic coils or permanent magnets so that it could use an MR fluid as the damping medium. Obviously the type and viscosity of the fluid (i.e. particle, size and type) could be varied to meet predetermined damping characteristics.

Regarding claims 2-4 these requirements are fairly suggested by the references above.

6. Claims 8,9,12,13,16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubel in view of Gordaninejad et al. and Davis '341.

Regarding claims 8-9,12,13,16-18 Rubel in view of Gordaninejad et al. are relied upon as explained above.

The patent to Davis shows it is known that a device such as Rubel could be modified to be used in place of the struts 28 in a vehicle suspension system.

Allowable Subject Matter

7. Claims 5-7,10,11,14,15,19,20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited and those cited by applicants have been relied upon at least in part for reaching the conclusions of obviousness above.

Consequently it is recommended these references be reviewed before preparing a response to the action above.

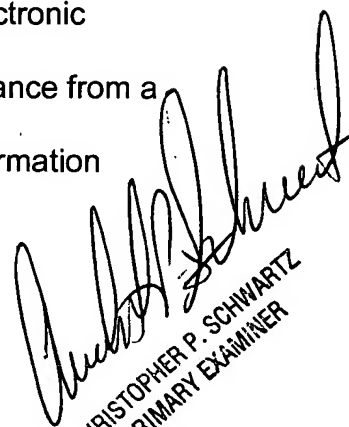
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 571-272-7123. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3683

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cps
11/08/06



CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER